REMARKS

Reconsideration of this application is respectfully requested.

In the Official Action, the Examiner rejects claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,681,260 to Ueda (hereinafter "Ueda") in view of U.S. Patent No. 6,958,577 to Biglieri (hereinafter "Biglieri").

In response, Applicants respectfully traverse the Examiner's rejection under 35 U.S.C. § 103(a) for at least the reasons set forth below.

The Examiner argues that Ueda discloses all of the features of independent claim 1, with the exception of a moving means for moving the examination table relative to the magnetic-field generating means, for which the Examiner cites Biglieri. The Applicants respectfully disagree.

Ueda discloses a capsule-type endoscope. Although not clear from Ueda, the capsule-type endoscope disclosed therein may be guided with an externally located magnetic field. All of the embodiments disclosed in Ueda teach a table on which a patient lies that is fixed and a magnetic force generating apparatus that is movable with respect to the table (see, for example, Figures 7, 20a, and 23).

Biglieri discloses a table/system for diagnostic imaging. The table is used together with a magnetic structure (1) for imaging a patient. The magnetic structure can be a Magnetic Resonance Imaging structure (MRI) or an MRI and ultrasound imaging apparatus (column 1, lines 21-24). Column 5, lines 23-30, with reference to Figure 6, discloses that the magnetic structure or the table, or both, may be displaced relative to each other.

Independent claim 1 recites a capsule endoscope having a movement controlled by an externally applied magnetic field, a magnetic field generating means for generating the

magnetic field to control the movement of the capsule endoscope and a moving means for moving the examination table relative to the magnetic field generating means.

Firstly, since Ueda discloses a fixed table and Biglieri discloses a movable table for moving a magnetic-field generating means **used for imaging a patient**, neither reference discloses or suggests a moving means for moving the table relative to a magnetic-field generating means **used to control the movement of a capsule endoscope**. That is, the magnetic structure of Biglieri is not used to control the movement of anything, but is merely used for imaging. Thus, even the combination of Ueda and Biglieri does not disclose all of the features of independent claim 1.

Therefore, independent claim 1 is not rendered obvious by the cited references because neither the Ueda patent nor the Biglieri patent, whether taken alone or in combination, teach or suggest a capsule endoscope system having the features discussed above. Accordingly, claim 1 patentably distinguishes over the prior art and is allowable. Claims 2-17 being dependent upon claim 1 are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-17 under 35 U.S.C. § 103(a).

Secondly, the Applicants respectfully submit that there is no motivation or suggestion to combine the teachings of the Ueda reference with the teachings of the Biglieri reference. Ueda only discloses fixed tables for use with imaging devices such as a capsule-type endoscope where a magnetic-field generating means moves to control the movement of the imaging means (e.g., capsule-type endoscope). Ueda does not suggest or otherwise contemplate the use of a movable table. In Biglieri, the magnetic-field generating means does not control the movement of any other device but is itself the imaging means (e.g., MRI). Thus, those skilled in the art would not look to Biglieri to combine with Ueda because Biglieri is not directed to a

capsule-type endoscope and is not directed to a magnetic-field generating means that is used to control the movement of any other device, and certainly not a capsule-type endoscope.

Further, 35 U.S.C. 103(a) "requires ... a showing that an artisan of ordinary skill in the art at the time of the invention, **confronted by the same problems as the inventor** and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined then in the claimed manner." Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332, 1337 (Fed. Cir. 2005) (emphasis added) (citing Ruiz v. A.B. Chance Co., 357, F.3d 1270, 1275 (Fed. Cir. 2004). Since the Ueda and Biglieri references are directed to solving different problems, those of ordinary skill in the art could not have been motivated to combine the teachings thereof.

Therefore, Applicants respectfully submit that the combination of Ueda and Biglieri is improper and must be withdrawn.

Thirdly, Applicants respectfully submit that the Biglieri reference is from a non-analogous art because it is directed to a different field of endeavor (MRI imaging-column 1, lines 13-16) and directed to solving a different problem (integrating structural components of imaging apparatus-column 1, line 65 to column 2, line 5).

To be considered analogous art, the references cited by the Examiner must be either in the same field as the invention or be reasonably pertinent to the problem faced by the inventor.[1] Applicants respectfully submit that neither of these requirements have been met in the present case.

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[1] See, *e.g.*, *In re Clay*, 966 F.2d 656, 23 USPQ 2d 1058 (Fed. Cir. 1992); *In re Paulsen*, 30 F.3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994); and *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ 2d 1767 (Fed. Cir. 1993).

With regard to the first prong of the non-analogous art test -- namely, whether a reference is within the field of the invention, the Federal Circuit has stated:

> We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances" -in other words, common sense- in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.[2]

Thus, a case-by-case analysis must be made to determine if a person of ordinary skill would look to the fields of the references for a solution to the problem facing the inventor.[3]

In clarifying how to determine the second prong of the test -- namely, whether a reference is reasonably pertinent to the particular problem with which an inventor was involved, the Federal Circuit has stated that:

> [a] reference is reasonably pertinent if ... it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem ... If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem ... [I]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.[4]

With regard to the first prong of the non-analogous art test, and in view of the Federal Circuit's narrow view of what is in the same field of endeavor,[5] it cannot be said that the Biglieri reference is within the same field of endeavor as the present invention. If memory

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[2] *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992).

[3] Id. See also, *In re Wright*, 848 F.2d 1216, 6 USPQ 2d 1959, 1962 (Fed. Cir. 1988) ("[A]s with all section 103 decisions, judgement must be brought to bear based on the facts of each case.").

[4] *In re Clay*, 23 USPQ 2d at 1060-1061.

[5] In *Wang Laboratories*, 26 USPQ 2d 1767, in which the present invention related to memory circuits and the cited reference referred to compact modular memories, the Federal Circuit held that the cited references were not in the same field of endeavor, stating that the reference "... is not in the same field of endeavor as the claimed subject matter merely because it relates to memories."

circuits are not considered in the same field of endeavor as compact modular memories, as held by the Federal Circuit in the *Wang* case[6], then the MRI system disclosed in the Biglieri reference cannot be considered to be in the same field of endeavor as a capsule endoscope system, which is not disclosed or suggested in the Biglieri reference. Thus, Applicants respectfully submit that the Biglieri reference is not in the same field of endeavor as the present invention.

With regard to the second prong of the non-analogous test, Applicants respectfully submit that the Biglieri reference is not reasonably pertinent to the particular problem with which the inventor of the present invention was involved.

The present invention is directed to obtaining information related to the position of the capsule endoscope in a body cavity of a subject and also observing an endoscopic image based on image signals captured by the capsule endoscope. This is a very different problem then faced by the inventors of the Biglieri reference, namely, integrating structural components of imaging apparatus (column 1, line 65 to column 2, line 5). To paraphrase the words of the Federal Circuit, the matter with which the references deal logically would not have commended themselves to the inventor's attention in considering his problem. Thus, since they are directed to different purposes, the inventor would accordingly have had no motivation or occasion to consider them.

Accordingly, Applicants respectfully submit that the Biglieri reference is not in the same field of endeavor as the present inventions, nor is it reasonably pertinent to the particular problem with which the inventor of the present invention was involved. Consequently, the Examiner is respectfully requested to withdraw the Biglieri reference, thereby rendering the 35 U.S.C. 103(a) rejection of claims 1-17 moot.

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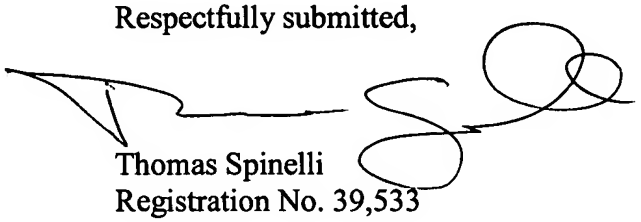
[6] Id.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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